

Appl. No. 09/674,443
Response Dated November 30, 2003
Reply to Office Action dated July 1, 2003

REMARKS

In view of the following remarks, the Applicant respectfully requests reconsideration of the present application.

Objections and Rejections

The Office Action dated July 1, 2003:

1. rejects claims 1-3, 12-15, 24, 26 and 40-41 under 35 U.S.C. § 103(a) as being unpatentably obvious over United States Patent no. 4,715,142 entitled "Self-Destruct Fish Hook" which issued December 29, 1987, on an application filed by Joseph D. Richard ("the Richard patent");
2. rejects claims 4-11, 16, 25 and 42-47 under 35 U.S.C. § 103(a) as being unpatentably obvious over the Richard patent as applied to claim 1, and further in view of ~~United States Patent no. 4,893,430~~ entitled "Multi-Jointed Beaded Fishing Worm Lure" which issued January 16, 1990, on an application filed by Timmy R. Barfield ("the Barfield patent");
3. rejects claims 22-24 and 37-39 under 35 U.S.C. § 103(a) as being unpatentably obvious over United States Patent no. 4,970,808 entitled "Electro-Acoustical Fishing Lure" which issued November 20, 1990, on an application filed by Lewis E. Massie ("the Massie patent"); and

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4. rejects claims 17-22 and 27-36 under 35 U.S.C. § 103(a) as being unpatentably obvious over United States Patent no. 5,697,182 entitled "Fishing Lure" which issued December 16, 1997, on an application filed by Nicholas A. Rodgers ("the Rodgers patent").

The Claimed Invention

The invention, as presently expressed in the independent claims, is fishing gear which includes an electret for inducing a strike response in fish.

Argument

Applicant respectfully submits that, for the reasons set forth in detail below, independent claims 1, 17, 22, 24, 27, 37, 40 and 43 traverse all bases for rejection appearing in the Office Action dated July 1, 2003. Because independent claims 1, 17, 22, 24, 27, 37, 40 and 43 traverse the rejections set forth in the Office Action dated July 1, 2003, Applicant respectfully submits;

1. that those independent claims together with all claims depending therefrom are allowable; and
2. therefore claims 1-47 now pending in this patent application are all allowable.

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The application presently includes eight (8) independent claims, i.e. claims 1, 17, 22, 24, 27, 37, 40 and 43. An element included in each of the combinations encompassed respectively by independent claims 1, 17, 22, 24, 27, 37, 40 and 43 is an electret.

1. Independent claims 1, 24 and 40 have been rejected under 35 U.S.C. § 103(a) based upon the Richard patent.
2. Independent claim 43 has been rejected under 35 U.S.C. § 103(a) based upon the Richard patent in view of the Barfield patent.
3. Independent claims 22, 24¹ and 37 have been rejected under 35 U.S.C. § 103(a) based upon the Massie patent.
4. Independent claims 17, 22² and 27 have been rejected under 35 U.S.C. § 103(a) based upon the Rodgers patent.³

¹ The Office Action dated July 1, 2003, confusingly rejects independent claim 24 based both:

1. upon the Richard patent in paragraph no. 4; and
2. upon the Massie patent in paragraph no. 6 that appears in the lower half of page 4.

² The Office Action dated July 1, 2003, confusingly rejects independent claim 22 based both:

1. based upon the Massie patent in paragraph no. 6 that appears in the lower half of page 4; and
2. based upon the Rodgers patent in paragraph no. 6 that begins at the top of page 5.

³ Note that the Office Action dated July 1, 2003, confusingly includes two (2) paragraphs which are numbered "6," one in the lower half of page 4, and the other beginning at the top of page 5.

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In rejecting independent claims 1, 24 and 40 in paragraph no. 4 based upon the Richard patent, the Office Action dated July 1, 2003, asserts:

The bioelectric simulating means [disclosed in the Richard patent] is formed by the anode and cathode formed adjacent the point of the hook. In reference to claim 1, it would have been obvious to provide Richard with the electret disposed on the shank adjacent the hook eye since a breakage at this point would also cause the hook to fail. (Emphasis supplied.)

In reference to claim 40, Richard shows all of the elements recited with the exception of the extension hardware coupled to the eye. However, it would have been obvious to employ old and well extension hardware to space the hook from the fish line. (Emphasis supplied.)

Paragraph no. 4 fails to expressly apply the Richard patent to independent claim 24.

In rejecting independent claim 43 in paragraph no. 4 based upon the Richard patent as applied to independent claim 1 in view of the Barfield patent, the Office Action dated July 1, 2003, fails to expressly apply the combined references to independent claim 43.

In rejecting independent claims 22, 24 and 37 in paragraph no. 6 in the lower half of page 4 based upon the Massie patent, the Office Action dated July 1, 2003, asserts:

In reference to claim 22, it would have been obvious to provide Massie with anodic and cathodic segments on the same strand although Massie shows separate strands the anodic and cathodic since the function is the same and no stated problem is solved.

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Paragraph no. 6 in the lower half of page 4 fails to expressly apply the Massie patent:

1. to independent claim 24; or
2. to independent claim 37.

In rejecting independent claims 17, 22 and 27 in the second paragraph no. 6 that begins at the top of page 5 based upon the Rodgers patent, the Office Action dated July 1, 2003, asserts:

In reference to claims 17 and 22, it would have been obvious to provide Rodgers with an electret on one of the strands rather than use two strands to make up the electret since the function is the same.

*solid
dielectric*

Paragraph no. 6 that begins at the top of page 5 fails to expressly apply the Rodgers patent to independent claim 27.

**The July 1, 2003, Office Action
Lacks a Proper Rejection of
Independent Claims 24, 27, 37 and 43**

As summarized in the immediately preceding four (4) paragraphs, the Office Action dated July 1, 2003, fails to expressly apply the cited references to independent claims 24, 27, 37 and 43. Because the July 1, 2003, Office Action lacks an express application of the cited references to independent claims 24, 27, 37 and 43, Applicant respectfully submits that those independent claims:

1. traverse rejection based upon the cited references; and
2. therefore, independent claims 24, 27, 37 and 43 together with all claims depending therefrom are allowable.

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**Independent Claims 1, 17, 22 and 40
Traverse the Rejections Appearing in
The July 1, 2003, Office Action**

First, in addressing the rejections of independent claims 1, 17, 22 and 4, the Applicant clearly sets forth below certain understandings regarding the express rejections which appear in the Office Action dated July 1, 2003.

As quoted above, the July 1, 2003, Office Action:

1. contains a rejection of independent claim 1 in paragraph no. 4 which expressly addresses the electret element appearing in the combination of claim 1;
2. contains rejections of independent claims 17 and 22 in the second paragraph no. 6 that begins at the top of page 5 which expressly addresses the electret element appearing in the respective combinations of claims 17 and 22;⁴ and
3. contains a rejection of independent claim 40 in paragraph no. 4 which, if understood as implicitly incorporating the bases upon which that paragraph rejects independent claim 1, expressly addresses the electret element appearing in the combination of claim 40.

⁴ Note that the rejection of claim 22 which appears in paragraph no. 6 in the lower half of page 4 fails to modify the structure disclosed in the Massie patent by adding thereto the recited electret.

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**The Exists No Motivation
to Modify the References**

The February 2003, revision of the Eighth Edition of the Manual of Patent Examining Procedure ("MPEP") on page 2100-126 states with regard to establishing a *prima facie* case of obviousness that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (

* * *

Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the references to do so." 916 F.2d at 682, 16 USPQ2d at 1432.)

Because the rejections of independent claims 1, 17, 22 and 40 appearing in the Office Action dated July 1, 2003, fail to identify in the references a suggestion that their modification is desirable, the Applicant respectfully submits that those independent

claims:

1. traverse rejection based upon the cited references; and
2. therefore, independent claims 1, 17, 22 and 40 together with all claims depending therefrom are allowable.

**The Richard Patent
Is Improperly Modified**

Specifically regarding the rejection which appears in paragraph no. 4 of the July 1, 2003, Office Action of independent

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claims 1 and 40 based upon a modification of the fishhook disclosed in the Richard patent, replacing the anode and cathode formed adjacent to the point of a fishhook with an electret disposed on the shank is allegedly motivated by a desire to prevent the fishhook's breakage and failure.

The Richard patent beginning in column 1 at line 67 states:

To enhance the surviveability of released fish, the present invention provides a method for greatly increasing the rate at which fish hooks used in the sport fisheries will degrade after immersion in seawater.

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In this method, at least one small section of the surface of the steel fish hook is designated as an anodic area where rapid corrosion and eventual hook breakage is desirable.

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When the hook is subsequently immersed in seawater, a galvanic couple is formed which results in the rapid corrosion of the anodic area and eventual breakage of the steel hook at that location.

The Richard patent in FIG. 3 and in a text that begins in column 3 at line 53 even goes so far as to quantify the improved fishhook breakage provided by the disclosed invention.

FIG. 3 is a graph 9 showing the relationship 10 between elapsed immersion time in seawater and hook strength for the self-destruct fish hook shown in FIGS. 1 and 2. After immersion in seawater, a delay period of 24 hours is shown representing the time required for the metal plating 3 to corrode away to expose the underlying steel body of the hook. When the more anodic annular surface of steel 4 is exposed, a more active galvanic couple is formed with the highly cathodic plating 8 so that the hook rapidly loses strength to eventually break at the point 12.

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The preceding texts excerpted from the Richard patent irrefutably establish that:

1. the invention's intended purpose is to improve fishhook breakage; and
2. the invention's method of operation is a galvanic reaction between seawater and the fishhook's anodic and cathodic materials.

Modifying a reference to such an extent that it no longer works for its intended purpose is an unobvious modification. The reference as so modified can no longer be applied to render a claimed invention obvious. "Indeed, if the French [fuel filter] apparatus were turned upside down, it would be rendered inoperable for its intended purpose." In re Gordon, supra citing Application of Schulpen 390 F.2d 1009, 1013, 157 USPQ 52, 55 (CCPA 1968). In Application of Schulpen the Court of Custom and Patent Appeals ("CCPA") reversed a Board of Appeals decision that a patent application's claims were obvious under 35 U.S.C. § 103 because an allegedly obvious modification of the reference would render the apparatus inoperable for producing the apparatus' intended product. A rejection of claims under 35 U.S.C. § 103 based upon inserting negative lenses, disclosed in one reference, into a camera accessory housing between a lens and a film plane, disclosed in a basic reference, was improper because it destroyed the basic

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reference for its intended purpose. Ex parte Westphalen, 159 USPQ 507, 508 (Bd. App. 1967). Similarly, claims to a deeply-drawable composite formed by coating a partially drawn non-woven fleece, allegedly disclosed in one reference, with a deep-drawable plastic film, disclosed in a second reference, were improperly rejected as being obvious because the combination destroyed the invention disclosed in the first reference. Ex parte Hartman, 186 USPQ 366, 367 (Bd. App. 1974).

The February 2003, revision of MPEP Eighth Edition in § 2143.01 at page 2100-127, in applying the controlling legal authority cited above expressly instructs examiners that claims are not to be rejected for obviousness under 35 U.S.C. § 103(a) relying upon a modification that renders the reference inoperable for its intended purpose. This text in MPEP expressly states as follows.

THE PROPOSED MODIFICATION CANNOT
RENDER THE PRIOR ART UNSATISFACTORY
FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically

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removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

Correspondingly, the February 2003, revision of MPEP in § 2143.01

further declares that:

THE PROPOSED MODIFICATION CANNOT
CHANGE THE PRINCIPLE OF OPERATION
OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection ~~based on a combination of references~~ disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Because the rejections of independent claims 1 and 40 appearing in paragraph no. 4 of the Office Action dated July 1, 2003:

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1. modify the disclosure of the Richard patent so it becomes unsatisfactory for its intended purpose; and
 2. change the principle of operation of the Richard patent;
- the Applicant respectfully submits that MPEP § 2143.01 declares the rejection improper, and that those independent claims:
1. traverse rejection based upon the cited references; and
 2. therefore, independent claims 1 and 40 together with all claims depending therefrom are allowable.

**The Massie and Rodgers Patents
Are Improperly Modified**

The invention disclosed in the Massie patent operates on the principle of galvanic action, i.e. a voltaic cell. Operation of the invention disclosed in the Rodgers patent is energized by a battery. Incorporation of an electret into the structures disclosed in either the Massie patent or the Rodgers patent would change the principle upon which either of these references operate. Consequently, in accordance with MPEP § 2143.01 as revised February 23, 2003, modification of the Massie and/or Rodgers patents by incorporating an electret therein is an unobvious modification.

Because the rejections of independent claims 17 and 22 respectively appearing in paragraph no 6 in the lower half of page 4 of the Office Action dated July 1, 2003, based upon the Massie patent, and in paragraph no. 6 that begins at the top of page 5 of

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the Office Action dated July 1, 2003, based upon the Rodgers patent change the principle of operation of the respective references, the Applicant respectfully submits that MPEP § 2143.01 declares the rejection improper, and that those independent claims:

1. traverse rejection based upon the cited references; and
2. therefore, independent claims 17 and 22 together with all claims depending therefrom are allowable.

Conclusion

For the reasons set forth above:

1. independent claims 24, 27, 37 and 43 traverse the rejections thereof appearing the Office Action dated July 1, 2003, because the Office Action fails to apply the cited references to those independent claims; and
2. independent claims 1, 17, 22 and 40 traverse the rejections thereof appearing in the Office Action dated July 1, 2003, because:
 - a. the Office Action fails to identify in the references a suggestion or motivation for their modification;
 - b. specifically with respect to the rejection of independent claims 1 and 40, the modification appearing in the Office Action:

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- i. modifies the reference so it becomes unsatisfactory for its intended purpose; and
- ii. changes the reference's principle of operation; and
- c. specifically with respect to the rejection of independent claims 17 and 22, the modification appearing in the Office Action changes the reference's principle of operation.

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Because for the preceding reasons independent claims 1, 17, 22, 24, 27, 37, 40 and 43 all traverse rejection based upon the references cited in the July 1, 2003, Office Action, Applicant respectfully:

1. favorable reconsideration and allowance of independent claims 1, 17, 22, 24, 27, 37, 40 and 43 together with all claims depending therefrom; and
2. prompt passage of the present application including claims 1-47 to issue.

Respectfully submitted


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